

REMARKS

The present request is submitted in response to the final Office Action dated December 29, 2006, which set a three-month period for response, making a response due by March 29, 2007, and with the initial two-month period for response expiring on February 28, 2007.

Claims 1 and 4-27 are pending in this application, with claims 5, 6, 10, 11 and 18 having been withdrawn from further consideration pursuant to an election requirement.

In the final rejection, claim 18, submitted in the Applicant's amendment of September 27, 2006, was withdrawn by the Examiner from consideration as being directed to a non-elected invention. The drawings were objected to under 37 CFR 1.83(a) as not showing the "spring element" in claim 14 and the "detent means" in claim 13. Claims 1, 4, 7-9, 12-17, and 19-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,774,992 to Lindenmuth in view of U.S. Patent No. 3,565,464 to Wolf.

Looking first at the withdrawal of newly submitted claim 18, the Applicants respectfully disagree with the imposed restriction. The Applicants submit that the features of claim 18 **are not only shown in Fig. 1**, but are also clearly provided throughout the description. On page 2, paragraph [0038], the features of claim 18 are disclosed. The views in Figs. 1a and 1b show detailed cut-outs from Fig. 1 for clearer representation of the suction flap 12. The practitioner would be able to make a direct reference to Fig. 1 from the description and Figs. 1a and 1b.

Thus, claim 18 also should be included in the claims elected. Reinstatement of claim 18 is respectfully requested.

Regarding the objection to the drawings, Figs. 1a and 1b have been amended to show the spring element as element 46 and the detent elements as element 45. The specification was amended to include these reference numerals. The Applicants respectfully submit that no new matter has been added, since these features were disclosed in the specification as originally filed.

Turning now to the substantive rejection of the claims under Section 103, the Applicants respectfully disagree with the basis for this rejection.

In Lindenmuth, a suction device is disclosed, which can be connected **as a separate component** with a hand-guided circular saw. For this purpose, a base body 12 has an upper cover 14 and a lower cover 16. Guide grooves 28, 30 run in these covers, in which the saw blade of the circular saw rotates. Between the covers 14, 16, ventilation channels 18 that are separated from one another are formed from intermediate walls 19. The ventilation channels 18 are formed, such that they are open, respectively, to the left and right on the contact points of the saw blade, and then are merged together in two ports 32, 34 (Lindenmuth, column 3, lines 3-12 and Fig. 1).

The ports 32, 34 can be connected with tubes 7, which can be connected in turn to vacuum units. The possibility also exists of providing only one support with one tube. The second support, then, is closed with a cap 35 (Lindenmuth, column 3, lines 13-20 and Fig. 3). During operation of the circular saw, it is therefore possible to suction the falling machining residue directly onto the

contact points of the saw blade and transport it outwardly through the channels 18 and the ports 32, 34.

The complete suction device 12 is a **separate component**, which can be combined additionally with a hand-guided circular saw, whereby its saw blade is mounted perpendicular in the guide grooves 28, 30. The suction device 12, therefore, does not have the character of a “protective cover or hood”, which in its shape and design accommodates a saw blade, as with the cover 10 in the present invention. The suction device 12 cannot be viewed as a cover of a circular saw. The circular saw shown in Lindenmuth (Fig. 3) has a protective cover or hood 6; however with this element, no residue guide is provided. Thus, the feature of an integrated, adjustable residue guide, which makes possible the two functional positions as defined in claim 1, is not disclosed in Lindenmuth.

If one only considers the suction device 12 alone, then it can be recognized that the use of the suction device 12 requires a few integration steps. The machine tool 2 must be attached to the suction device 12 and the ports 32, 34 must either be connected individually or commonly via a tube 7 to a vacuum unit. After these integration steps are performed, suctioning of machining residue is possible. Only in this configuration with simultaneous suction and the pull connected therewith is the machining residue conducted through the channels 18 and further, through the ports 32, 34. If the ports 32, 34 were connected in any manner directly to one another, in order to obtain a further functional position, then no machining residue could be conducted through them. Closing of both ports would have the same effect.

The functioning of the suction device 12 is limited to the named configuration, in that suction tubes are connected to the ports 32, 34, which then function as guides for machining residue outside of the suction device 12. It is not possible to achieve a position by a pivoting motion of the suction tubes, which repositions the guiding of the machining residue within the suction device 12.

The present invention pursues a different strategy than that of Lindenmuth. A cover 10, which is adapted in shape and design to a saw blade of a circular saw, is already equipped with an adjustable residue guide 12. The cover 10 and the residue guide 12 need not be separated from one another or altered in operation, since the residue guide 12 is integrated in the cover and since this forms an integral unit. With a simple pivoting motion, a position of the residue guide 12 *within* the cover 10 or *outside of* the cover can be achieved.

Lindenmuth provides the practitioner in the relevant filed with no suggestion or teachings for these features, since this reference provides only one functional position of the residue guide that is directed outwardly or externally.

A combination with the connection element 20 from the Wolf reference does not provide this additional functional position. The tube element 20 of Wolf is designed as a connection between a suction tube and a vacuum unit. As an additional component for extension between one of the ports 32, 34 and a suction tube of the Lindenmuth reference, only the residue guide to the outside would be provided. If the connection element 20 were mounted between the ports 32, 34, then a residue guide within the suction device is not possible. Also,

in this combination, it is not possible to bring a guide for machining residue into one position outside or into another position within a cover by a pivoting motion.

The Applicants therefore respectfully submit that the cited references would not lead the practitioner to the present invention as defined in the claims of the present application, whether the references are viewed alone or in the proposed combination. The combination of the references does not provide a reasonable functioning of the residue guide.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in **MPEP section 2143.01**. Please note also that the modification proposed by the Examiner would change the principle of operation of the prior art, so that also for this reason the references are not sufficient to render the claims prima facie obvious (see the last paragraph of the aforementioned **MPEP section 2143.01**).

For the reasons set forth above, the Applicants respectfully submit that claims 1-4, 7-9, and 12-27 are patentable over the cited art. The Applicants further request withdrawal of the final rejection and reconsideration of the claims in their present state.

In light of the foregoing amendments and arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss

appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

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